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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,704	09/23/2003	John J. Toben	6006-149-1	2213
7590 12/07/2009				
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EXAMINER				
SAUTHER, FLEMMING				
ART UNIT		PAPER NUMBER		
3677				
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12/07/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/668,704

**Applicant(s)**

TOBEN ET AL.

**Examiner**

Flemming Saether

**Art Unit**

3677

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 8-15 and 22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

Claims 8-15 and 22 remain in application as withdrawn.

***Claim Rejections - 35 USC § 103***

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siiter (US 6,901,969) in view of Wildi (US 3,590,464) and further in view of Bonnell (US 5,779,623). Siiter is similar to applicant's admitted prior art wherein a duct reinforcement rod is fabricated by inserting a conduit over a threaded element and then having an apparatus deforming the conduit to capture the threaded element (see Figs. 9). Siiter however does not disclose the apparatus deforming the conduit at two axially spaced locations to capture the threaded element there between. Wildi discloses a fabrication apparatus including a means for deforming a conduit at two axially spaced locations to capture a threaded element, particularly a nut, there between (see for example Fig. 5). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to modify the apparatus of Siiter for it is deform the conduit at a two axially spaced locations as disclosed in Wild so that a conventional hexagonal nut could be used to be more economical and versatile than a specialty nut with a groove as currently required in Siiter. Siiter further discloses a vertical orientation of the conduit. As to the positioning means, insertion means, and deformation means, Siiter discloses in the paragraph bridging columns 6 and 7 that various devices and mechanisms can be used to facilitate the crimping of the plug into the tube but, does not disclose a pair of opposed tube pushers. Bonnell discloses a positioning and insertion

means including a mechanism having a pair of opposed tube pushers (112, 114). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to use the mechanism including a pair of opposed tube pushers as disclosed in Bonnell to position the tube in modified Siiter. The mechanism disclosed Bonnell is described as an automated technique to improve the positioning of a tube over a manual technique and the skilled artisan would have recognized the similar improvement could be applied to modify Siiter yielding the same results. Indeed the automated mechanism would be an improvement over the manual operation because it would be more efficient.

Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siiter in view of Wildi as applied to claims 1 and 3 above, and further in view of Di Maio (US 4,005,519). Modified Siiter does not disclose details of the apparatus as claimed. Di Maio discloses an apparatus having a rack and pinion gear mechanism (see Figs. 17 and 18). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide the apparatus of modified Siiter with a rack and pinion gear mechanism as disclosed in Di Maio since rack and pinion arrangements are well known machine elements for conveniently converting rotary to linear motion which would be convenient method for automating the linear motion required the conduit on modified Siiter. As regards claims 6 and 7, the crimping blocks are disclosed in Siiter (again, refer to Figs. 9).

***Allowable Subject Matter***

Claim 21 remains in the application as allowable.

***Response to Remarks***

The 112 second paragraph rejection has been withdrawn but, it should be noted that some of the withdrawn claims require similar corrections.

Applicant argues the claims are allowable over the combination of Siiter, Wildi and Bonnell because there is no motivation for the combination.

First applicant argues that the combination of Siiter and Wildi would not be motivated because it would not be expected to be successful and would require significant reengineering. In response, while the examiner agrees with applicant understanding of the references, the examiner maintains the combination would have obvious the combination would yield predictable results and while there would be some reengineering required it would be with the level of ordinary skill in the art. Both Siiter and Wildi are concerned with attaching, even crimping, a threaded plug to a conduit thus since both references are doing the same thing the end result would clearly be predictable and successful. The combination is merely replacing one means of for crimping a conduit onto a plug for another means and in the same field of endeavor, there is no reason to believe it would not be successful. Also, while some reengineering would be required, the test for obviousness is not whether the features of a secondary

reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Second, applicant argues that the combination with Bonnell would not have been obvious since Bonnell is from a different field of endeavor in that it is from the medical field and does not deform the conduit. In response, the examiner again agrees with applicant's understanding of Bonnell. However, as noted by applicant, Bonnell is disclosing a "positioning and insertion means" which the person of ordinary skill in the art concerned with Siiter and Wildi would have considered pertinent because it is in reference to a conduit. Indeed each of the references: Siiter, Wildi and Bonnell are concerned with positioning and inserting a conduit thus the person of ordinary skill would have considered all the references and recognized the advantages of the automated mechanism provided by Bonnell.

Applicant does not provide specific arguments of *Di Maio* thus no response is believed necessary.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 571-272-7071. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Flemming Saether  
Primary Examiner  
Art Unit 3677

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